

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Pilux & Danpex, S.A.

Serial No.: 10/537,183

Filed: 10/5/2004

For: Fluorescent Lamp Reflectors

Customer Number: 07617

Attorney Docket No.: 2626

T.C./Art Unit: 2875

Examiner: Jessica L. McMillan

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RENEWED PETITION TO REVIVE APPLICATION UNDER 37 CFR 1.137(b)

Sir:

Applicant seeks revival of the subject application according to Applicant's Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.37(b), dated March 26, 2009. The aforementioned petition was denied by the Decision on Petition dated July 17, 2009, which indicated that a request for reconsideration could be filed by September 17, 2009.

The foregoing Decision on Petition stated, with reference to 37 CFR 1.137 (b), that Applicant had not shown that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional. Applicant files the present Renewed Petition to Revive Application under 37 CFR 1.137 (b).

Applicant incorporates by reference the following documents of record in this matter:

1. Applicant's Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.37(b), dated March 26, 2009 (hereinafter, "Applicant's Petition").
2. Applicant's Corrective Declaration dated April 21, 2009 (hereinafter, "ACD").
3. Applicant's Supplemental Declaration dated September 17, 2009 (hereinafter, "ASD").

Statement of Facts

The subject application became abandoned when the Office Action dated November 16, 2006 was not responded to within six months, resulting in abandonment of the application under 35 U.S.C. §133. Applicant decided not to respond to the Office Action due to the patent-nullifying effect of the Underwriters Laboratory (UL) decision to refuse safety certification of the invention. ACD ¶¶3-11. For instance, Applicant stated in ACD ¶13: "As discussed above, [non-response] is because the potential property right was, for practical purposes, eviscerated by UL's refusal in 2006 to certify the safety of the [inventive] reflector." In support of this statement, Applicant indicates in ACD ¶¶7-10, that without a UL safety certification, the market for the invention was far too minuscule to engender the exclusionary power of a patent.

But for UL's intervening patent-nullifying decision, Applicant wanted to pursue the present application and to timely respond to the mentioned November 16, 2006 Office Action. Substantiating Applicant's desire to pursue the present application were:

1. Applicant's belief, especially in view of patent counsel's correspondence, that the claims of the subject application were patentable over the prior art and were of adequate scope to justify the expense of pursuing the application. ASD ¶¶5-6; ASD Exh. A).
2. Applicant believed that the market demand for the invention was consistently strong throughout all relevant time periods, that is, including the period from the November 16, 2006 date of the Office Action to which a response was not timely filed, and continuing through the filing of the March 26, 2009 petition to revive the subject application and through the present time. ASD ¶¶ 3-4.
3. At all relevant times as just mentioned, Applicant was ready, able and willing to pay for pursuing the subject application *but for* the intervening patent-nullifying decision of Underwriters Laboratory. ASD ¶2.

Point 1: Applicant did not intend to abandon the application since the different aspects of Applicant's chosen course of action fail to provide a logical basis to infer intent to abandon property rights

As the facts of this case demonstrate, Applicant chose not to respond to the outstanding Office Action within the six-month period allowed for response as a result of an intervening cause – UL's decision to refuse safety certification of the invention. UL's decision is a type of force majeure, or unanticipated intervening cause, the effect of which is unavoidable and insurmountable.

In re Application of G, 11 USPQ2d 1378 (Comm'r Pat. 1989), concerned a decisionmaking process in which applicants and their assignee deliberately chose not to file a response to rejection of the claims in an outstanding office action. The applicants and their assignee chose not to respond to the office action based on a determination—later argued as mistaken—that “the Office Action could not be overcome.” 11 USPQ2d at 1380. The Commissioner of Patents held that the decision of the applicants and their assignee to allow that application to become abandoned “cannot be considered to amount to an unintentional abandonment within the meaning of 37 CFR 1.137(b).” 11 USPQ2d at 1381. In reaching this conclusion, the Commissioner of Patents considered the intent of the applicants and their assignee, reasoning, for instance, that applicants’ and assignee’s “agent consciously decided not to respond to the August 8, 1986 Office Action.” 11 USPQ2d at 1381.

As in *In re Application of G, supra*, Applicant here submits that the intent of the present Applicant in not responding to the outstanding office action must be considered. In any event, remedial statute 35 U.S.C. §41(a)(7) requires that the intention of the applicant be inquired into, since the foregoing statute authorizes a petition for reviving an abandoned application where the abandonment happened “unintentionally.” Applicant submits that there are different varieties of conscious decisionmaking in not responding to an office action, and that the variety of decisionmaking in this case warrants a different outcome from *In re Application of G, supra*.

The table set forth below considers three different varieties of conscious decisionmaking in not responding to an office action. The first column contrasts rationales for not responding to an office action in three different categories (1), (2) and (3). The table includes a second column asking whether the applicant's decision not to

respond forms a logical basis to infer intentional abandonment. This question must be asked in some cases, such as the present case, in order to faithfully adhere to the requirement of 35 U.S.C. §41(a)(7), discussed above, that remedial relief is available for applications that are abandoned “unintentionally”—a question of the intent of an applicant. The third column comments on each of the categories.

In the following table, the first category (1) relates to an applicant's decision not to respond based on an (unreasonable) mistake concerning patentability of the claims. This was the situation in *In re Application of G*, 11 USPQ2d 1378 (Comm'r Pat. 1989) and *In re Maldague*, 10 USPQ2d 1477 (Comm'r Pat. 1988), cited in the July 17, 2009 Decision on Petition in this case. With such decisions not to respond to an office action based on a conscious determination of lack of patentability, Applicant here believes that such actions logically support the inference of intent to abandon an application.

Varieties of Conscious Decisionmaking in Not Responding to an Office Action			
Rationales		Is this a logical basis to infer intentional abandonment?	Comments
1	Decision made due to (unreasonable) mistake re patentability, etc.	Yes	Authority is <i>In re Application of G</i> , 11 USPQ2d 1378 (Comm'r Pat. 1989) and <i>In re Maldague</i> , 10 USPQ2d 1477 (Comm'r Pat. 1988).
2	There was a patent-nullifying force majeure	Ambiguous (resolved here to show No)	Lack of “meaningful patent protection”
3	Decision made at gunpoint	No	Self-Evident

Jumping to the third category (3) in the above table, consider an applicant being held at gunpoint on the last day to respond to an office action. The applicant decides (deliberately) not to respond to the office action since his life will be jeopardized if he takes actions to respond to the office action. While applicant's course of action was clearly a consciously (i.e., deliberately) chosen course of action, it would be illogical in this category to infer from this fact alone that applicant possessed the intent to abandon the application.

The second category (2) describes the present case. Applicant's decision not to respond to the outstanding office action was made after the intervening patent-nullifying force majeure decision of Underwriters Laboratory to refuse safety certification of the subject invention.

Patent-Nullifying Decision of Underwriters Laboratory

The Underwriters Laboratory (UL) force majeure decision to refuse safety certification of the invention relegated the patent application to a mere hollow shell, devoid of meaningful patent rights. The UL decision was, in effect, a patent-nullifying decision, because in the absence of UL safety certification, as Applicant believed, the "potential market in the U.S.A for the subject reflector would be severely restricted for any company." ACD ¶9. Further, whatever severely restricted (i.e., minuscule) sales of the invention were possible would be far too low to enable enforcement of a patent (ACD ¶10) as is necessary to achieve market exclusivity.

Applicant's concept of lack of meaningful patent rights due to inability to achieve market exclusivity deserves compelling weight. The identical concept was articulated to Congress by the Chief Counsel for the United States Food and Drug Administration (FDA) in relation to the Hatch-Waxman Amendments (now 35 U.S.C. § 156) on August 1, 2003. Thus, the FDA's Chief Counsel Daniel E. Troy, in testifying to the Senate Committee on the Judiciary concerning the often-lengthy FDA pre-market approval period during which the FDA prohibited sales of patented drugs, stated that an important public policy goal of the Hatch-Waxman Amendments was "to ensure that brand-name drug manufacturers would have meaningful patent protection¹ and a period of marketing exclusivity to enable them to recoup their investments in the development of valuable new drugs." *Drug Price Competition and Patent Term Restoration Act of 1984 (Hatch-Waxman Amendments)*, Senate Committee on the Judiciary (2003) (statement of Daniel E. Troy, Chief Counsel, U.S. Food and Drug Administration). The "meaningful patent protection" to which FDA Chief Counsel Troy testified relates to the patent term extension afforded by the Hatch-Waxman Amendments, during which a drug company could finally sell their patented drugs.

¹ "Meaningful patent protection" as used by FDA's Chief Counsel Daniel E. Troy and by Applicant herein does not refer to the breadth or scope of patent claims, which in other contexts could be construed as bearing on whether a patent is meaningful or not. Here, "meaningful patent protection" relates to the context of having an available market from which to recoup investment in the development of inventions. In the absence of such market, the patent is no more than a hollow, useless shell, devoid of any meaningful rights.

Drug companies (prior to the Hatch-Waxman Amendments) and the present Applicant were both faced with the similar situation of being foreclosed from "meaningful patent protection" during the periods when the FDA or the Underwriters Laboratory safety approval was withheld. It would be pointless for Applicant to acquire a patent lacking, in the words of FDA Chief Counsel Troy, "meaningful patent protection and a period of marketing exclusivity to enable [it] to recoup [its] investments in development of [a] valuable [invention]." *Id.* What remained was a mere hollow shell of a patent application; that is, an application devoid of any meaningful patent rights and the inability of Applicant to have a period of exclusivity to enable it to recoup its investments in development of the invention. There were essentially no meaningful rights for Applicant to abandon. The following illustration develops this point:

Car with tax lien. Consider the owner of a car, who loves the car, but who sees a federal marshal take possession of the car for satisfaction of a federal tax lien. The owner would naturally be expected to walk away from the car and not assert ownership of the car by continued registration of the car, etc. Such acts would seemingly constitute an abandonment of the car. However, if at some time later it is determined that the tax lien was defective and should not have been granted, in determining whether the car owner intentionally abandoned the car, it would be improper to infer an intention to abandon the car from merely the car owner's deliberately chosen course of action taken in walking away from the car. Rather, it can be seen that car owner believed that its rights in the car were rendered a nullity by the federal marshal's taking possession of the car. The car owner could not logically intend to abandon a nullity—i.e., that in which it has no rights.

In the present case, in the face of the intervening patent-nullifying decision of Underwriters Laboratory, Applicant submits that its decision not to respond to the outstanding office action, taken alone, cannot serve as a logical basis to infer that Applicant intended to abandon its rights in the patent application. This is because the intervening force majeure decision of Underwriters Laboratory made any patent rights meaningless—i.e., effectively a nullity—and Applicant could not logically have intended to abandon a nullity.

Still, however, Applicant agrees that applicants may have other reasons to abandon an application, such as due to a determination of lack of patentability, etc.

Accordingly, Applicant addresses a myriad of possible reasons for abandoning an application, as follows, and responds that such reasons are wholly inapplicable to its situation. The following list includes all of the possible reasons that are as set forth in the July 19, 2009 Decision on Petition:

1. “[A] conclusion that *** the invention lacks sufficient commercial value to justify continued prosecution.” P. 2. In fact, Applicant was well-aware during all relevant time periods involved, that is, from before the November 16, 2006 Office Action to which a response was not timely filed, continuing through the filing of the March 26, 2009 petition to revive the subject application and through the present time, that the market demand for the invention has remained strong, and therefore the invention possessed sufficient commercial value to justify continued prosecution. ASD ¶3. In fact, Applicant here was ready, able and willing to timely respond to the outstanding Office Action *but for* UL’s intervening patent-nullifying force majeure decision. ASD ¶2.
2. “[A]n applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office Action.” P. 2. In fact, Applicant here did consider the claims be patentable over the references relied on in the Office Action. ASD ¶5; ASD Exh. A.
3. “[T]he applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent.” P. 2. In fact, Applicant here did consider the probable claims that would be allowed to be of sufficient breadth or scope to justify the financial expense of obtaining a patent. ASD ¶6.
4. “[T]he applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining a patent.” P. 2. In fact, Applicant here did consider the probable claims that would be allowed to be of sufficient breadth or scope to justify the financial expense of obtaining a patent. ASD ¶7.
5. “[T]he applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining a patent.” P. 2. In fact, Applicant here did consider the probable claims that would be allowed to be of sufficient value to maintain an interest in obtaining a patent. ASD ¶8.

6. “[T]he applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.” P. 2. In fact, Applicant here was ready, able and willing to timely pay patent fees and patent prosecution expenses *but for* UL’s intervening patent-nullifying force majeure decision. ASD ¶9.

Thus, none of the foregoing possible reasons for not responding to an Office Action apply to the present case, and therefore such inapplicable reasons cannot form a logical basis to infer an intent to abandon rights in the patent application.

The foregoing list of possible reasons (1) – (6) and Applicant’s showing of inapplicability of such reasons removes any ambiguity from the various aspects of Applicant’s course of action in not responding to the Office Action. Applicant wanted to continue with the application, but the intervening force majeure decision of Underwriters Laboratory made any patent rights meaningless—i.e., effectively a nullity—and Applicant cannot logically intend to abandon a nullity. Therefore, the present application was abandoned unintentionally.

Point 2: In view of Applicant's unintentional abandonment of the application, there is no need to reach the "change in circumstances" issue

In the present case, Applicant has made the "serendipitous" determination that sales of the invention outside of the U.S.A. have resulted in sufficient safety data to enable it to now seek a favorable decision on safety certification from Underwriters Laboratory (ACD 1115-16). As the following shows, the statement in the Decision on Petition referring to a "change of circumstances" (p. 2, penultimate paragraph) cannot be used to deny the present petition.

The cited "change of circumstances" issue in the July 17, 2009 Decision on Petition arises only after a finding that abandonment of the application was intentional. Since this Renewed Petition to Revive Application under 37 CFR 1.137(a) shows that the application was abandoned unintentionally, there is no need to reach the "change of circumstances" issue.

Conclusion

The present application should be revived.

Certificate of Filing

I certify that the foregoing document and any document(s) referenced below are being filed electronically with the USPTO using the private PAIR system on the date stated below.

Dated: September 17, 2009

Respectfully submitted,



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Enclosure: Applicant's Supplemental Declaration